Attorney's Docket No.: 02103-413001
Client's Ref. No.: AABOSS37

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Applicant : J. Richard Aylward et al.
Serial No. : 09/886,868
Filed : June 21, 2001

Art Unit : 2643
Examiner : Brian T. Pendleton

Title : Audio Signal processing

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attached to this facsimile communication cover sheet is Response A to Restriction Requirement, faxed this 1st day of April, 2005, to the United States Patent and Trademark Office.

Respectfully submitted,
FISH & RICHARDSON P.C.

Date: April 1, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Mail Stop Amendment
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE A TO RESTRICTION REQUIREMENT

Dear Commissioner:

Responsive to the office action dated March 3, 2005, application owner provisionally elects claims 1-27, 36-41 and 46-54 in group I should the requirement for restriction be maintained and provisionally elects species I disclosed in FIG. 3A and at least claims 1-6, 8, 9, 11, 12-23, 26, 27, 46-49 and 54 readable thereon should the requirement for restriction be maintained and no generic claim is finally held to be allowable.

The requirement for restriction is respectfully traversed.

35 U.S.C. §121 reads, "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." Thus, restriction is proper only if the inventions are "independent and distinct." M.P.E.P. headed 802.01, "Meaning of 'Independent', 'Distinct' reads as follows:

> INDEPENDENT
> The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, (1) species under a genus

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which species are not usable together as disclosed or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term "related" is used as an alternative for "dependent" in referring to subjects other than independent subjects.

The Examiner has not shown that the claims in each group "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER." Should the requirement for restriction be made final, the Examiner is respectfully requested to rule that the claims in each Group "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

The Examiner has made no showing whatsoever that the inventions are INDEPENDENT. M.P.E.P. 803 provides, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

And M.P.E.P. 803.01 provides, "IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION.

Manifestly, search and examination of the entire application can be made without serious burden because prior art related to the method for processing audio signals in Group I must be searched in connection with examining the method for processing audio signals in Group II and the method for processing an audio signal in Group III, and there are only eight claims in Group II and only four claims in Group III.

The Court of Customs and Patent Appeals has also recognized that "independent and distinct" means "independent and distinct." *In re Weber*, 198 U.S.P.Q. 328 (C.C.P.A. 1978); *In re Haas*, 198 U.S.P.Q. 334, 336 (C.C.P.A. 1978).

In a decision dated June 23, 1977, on a petition filed June 13, 1977, Group 1210 Director Alfred L. Leavitt in granting the petition to withdraw the requirement for restriction said:

> Current Office policy is not to require restriction between related inventions when no substantial burden is involved in the examination of all claims in a single application.

And in a decision dated 3 December 1993 on a petition filed March 12, 1993, Group 1100 Deputy Director John Doyle said:

> Restriction was required between (I)method for epitaxial deposition and (II)epitaxially deposited product (Paper No. 4). However, the examiner failed to present any convincing basis for the holding that the inventions as above grouped are distinct. The claimed inventions must be independent or distinct, and the examiner "must provide reasons and/or examples to support conclusions . . .". Further, the field of search for the alleged distinct inventions is seen to be coextensive, hence, no serious burden is seen to be incurred by examination of all pending claims. MPEP 803 under "Criteria For Restriction Between Patentably Distinct Inventions".
>
> The Petition is GRANTED.

That all the claims are related as subcombinations usable together in a single combination has nothing to do with the requirements of establishing that the groups are both independent and distinct and that search and examination of the entire application cannot be made without serious burden. That the inventions are related precludes a ruling that the groups are independent and distinct for each of Groups II and III is related to elected Group I.

Manifestly, search and examination of the entire application can be made without serious burden because prior art related to the claims in Group I are likely to disclose subject matter which must be searched in connection with examining claims in each of the related groups.

Accordingly, it is respectfully requested that the requirement for restriction be withdrawn. If the requirement for restriction is repeated, the Examiner is respectfully requested to rule that the claims in each group are PATENTABLE (novel and unobvious) over each other and explain why all the claims cannot be examined without serious burden.

No fee is believed to be due. However, the Commissioner is respectfully requested to charge any fees to Deposit Account No. 06-1050, Order No. 02103-413001.

Respectfully submitted,
FISH & RICHARDSON P.C.

Date: APR - 1 2005

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